

REMARKS/ARGUMENTS

In view of the remarks herein, favorable reconsideration and allowance of this application are respectfully requested. Claims 21, 23, and 25 are pending for further examination.

Claims 21, 23, and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Martin et al. (U.S. Patent No. 5,848,398), in view of Wilder (U.S. Patent No. 5,408,417), Banks et al. (U.S. Patent No. 5,559,714), Mauldin (U.S. Patent No. 5,748,954), Alavi (U.S. Patent No. 5,970,467), and Pritt et al. (U.S. Patent No. 5,473,746). This six-way § 103 rejection is respectfully traversed for at least the following reasons.

The Office Action alleges that Martin at col. 7, lines 36-43 discloses a jukebox system with a display operable to display a list of songs in a popup menu from which a user is to select a song not yet available on the jukebox system for download to the jukebox system. Applicant respectfully disagrees.

A careful reading of the portion of Martin cited in the Office Action indicates that the provided display only presents a prompt, requesting customers to enter new songs requests. This sort of prompt requires the customer to enter the name of the new song to be possibly retrieved for subsequent playback on the audiovisual system. There are no real choices with this sort of text-based prompt. It follows, then, that there is no selection from a list. As a result, Martin does not teach or suggest a display operable to display at least one option for selecting a song, not yet available on the jukebox system for download to the jukebox system.

As will be appreciated by those skilled in the art, the claimed list is advantageous compared to a basic prompt. An example advantage of using a list from which a new song may be selected rather than typing the name of the song is that the customer is sure that the song may

be downloaded from the host server. Another example advantage is that the selection from a list or menu helps reduce the likelihood of typographical or clerical errors that could result in user frustration, while also potentially increasing speed at which selections are made. The rejection is flawed, at least because a text-based prompt is not a list.

The Office Action also argues that Alavi at col. 1, line 50 to col. 2, line 24 teaches a reward routine for presenting the customer with a reward is processed, after a determination routine has determined whether the questionnaire was completed.

In this passage, Alavi describes a reward routine for rewarding a customer after answering to a questionnaire. This reward routine, however, does not include a verification stage. The only action described as being taken in Alavi after a questionnaire is filled in involves sorting of the answers. See col. 2, lines 11-15. Alavi simply teaches a rewarding routine that provides rewards to customers -- without any verification that the questionnaire has been completed. Thus, contrary to the assertions in the Office Action, Alavi does not teach or suggest rewarding the customer after a determination routine has determined whether the questionnaire was completed. The rejection is flawed for this reason, as well.

Applicant respectfully disagrees with the Office Action's contention that one skilled in the art at the time of the invention would have found it obvious to introduce Pritt's popup menu teachings into the alleged five-way combination. Pritt, of course, is unrelated to jukeboxes, audiovisual reproduction devices, and the like. It is questionable that one skilled in the art would look to Pritt when attempting to improve a jukebox device.

As discussed above, Martin teaches a display that presents a prompt that requests customers to enter new songs requests. Martin thus solves the problem of how to make songs available to a user via an interface completely unlike that which is claimed. And because this problem is already solved, one skilled in the art would see no reason to "solve it again" by looking to Pritt or any other popup menu- or list-based system. The hindsight reasoning in the Office Action is unsupported by facts of record. Indeed, the Office Action appears to use language close to that which is common for officially noticed facts (i.e., allegations about that which is "notoriously well known") but stops short of the required evidentiary finding. The Examiner is kindly requested to come forward with some reference of record establishing that which is alleged (and currently unsupported) -- including all of the subjective statements made in the Office Action in the paragraph bridging pages 8-9. Until such facts are established, there is insufficient basis to support the legal conclusion of obviousness. At present, there is no factual basis as to why one skilled in the art would prefer the popup menu to the prompt solution. There is no hint in Martin that its prompt should be replaced with any other solution. And aside from Applicant's own disclosure, there is nothing in the record as to why one would want to replace one perfectly valid and workable search tool with another.

In view of the foregoing, reconsideration and withdrawal of the six-way § 103 rejection is respectfully requested.

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Appl. No. 09/621,677

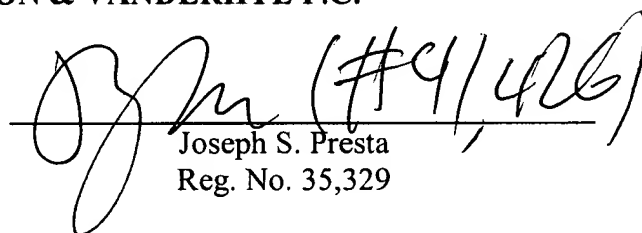
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In view of the foregoing remarks, withdrawal of the rejections and allowance of this application are earnestly solicited. Should the Examiner have any questions regarding this application, or deem that any formalities need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

Respectfully submitted,

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